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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,020	06/10/2002	Rainer Blum	P 290586	7773
909	7590	01/18/2005	EXAMINER	
PILLSBURY WINTHROP, LLP			ROBERTSON, JEFFREY	
P.O. BOX 10500			ART UNIT	
MCLEAN, VA 22102			PAPER NUMBER	
			1712	
DATE MAILED: 01/18/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/069,020

**Applicant(s)**

BLUM ET AL.

**Examiner**

Jeffrey B. Robertson

**Art Unit**

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 November 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,11,12 and 14-27 is/are pending in the application.  
4a) Of the above claim(s) 11,12 and 14-27 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1,2 and 4-8 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION*****Information Disclosure Statement***

1. It is noted that there are a number of X references listed on the International Search Report that were not addressed in the previous office action. WO 97 25361 A, U.S. Patent No. 5,763,099, WO 97 38020 A, U.S. Patent No. 5,342,554, and EP 0 702 067 A are cited as X references. None of these references teaches or suggests the present claims. Specifically, none of these references teaches or suggests the combination of an unsaturated polyester containing the structural units (I) or (II) and a crosslinking agent containing terminal and/or pendant isoprenyl groups. WO 86 03757 A (U.S. equivalent U.S. Patent No. 4,777,209) teaches liquid polyester compositions, where the polyester contains structural units (I) or (II). This reference does not teach or suggest hot melt compositions as set forth in the instant claims.

***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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3. Claims 1, 2 and 4-8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 6,787,581. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of this application and the claims of 6,787,581 overlap.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 2 and 4-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blum or WO 97/25361. Blum and WO 97/25361 are believed to be equivalents.

This rejection is based on the premise that applicant's components (A) and (B) may be the same.

The references teach reactive prepolymeric organic compounds that have structures having abstractable hydrogens that include isoprenyl group and dicyclopentadiene that can be cured without free radical initiators. See Blum at col. 2, lines 2-60 (structures 1 through V<sub>a</sub>). The reactive compounds can be used in the form of solids that can be melted for use. See Blum at col. 11, lines 17-18. The reactive compounds may carry photoinitiators to enhance photosensitivity. See Blum col. 10, line 64 through col. 11, line 3. In columns 9 and 10 of the Blum reference, the prepolymeric organic compounds of Blum may be polyesters containing the structural formulas I

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through  $V_a$ . In this situation, components (A) and (B) may be the same. Since Blum teaches that the prepolymeric compounds may be used by themselves in column 10, lines 44-45, when (A) and (B) are the same, it appears that applicant's claims are not distinguished from the prior art.

As suggested by each of the references, it would have been obvious to use a reactive prepolymeric organic compound having isoprenyl groups where the component is optionally derived from dicyclopentadiene, in order to obtain a hot melt resin composition that can be cured without free radical initiators.

### ***Response to Arguments***

6. Applicant's arguments filed 11/1/04 have been fully considered but they are not persuasive.

Applicant argues that the combination of prepolymeric organic compounds with unsaturated polyesters set forth by the Blum reference in column 3, lines 27-32 does not set forth the combination of components required in the presently amended claims. Specifically, applicant argues that because Blum teaches that the unsaturated polyesters are devoid of groups having readily abstractable hydrogens, the unsaturated polyesters of Blum cannot include the structures now set forth in the claim for applicant's component (A), since these structures are indicated by Blum to contain readily abstractable hydrogens. The examiner agrees with this interpretation. However, since component (A) of the present claims may also contain terminal and/or pendant isoprenyl groups, the difference between components (A) and (B) in applicant's claim 1 is not apparent. As pointed out by applicant, in columns 9 and 10 of the Blum

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reference, the prepolymeric organic compounds of Blum may be polyesters containing the structural formulas I through V<sub>a</sub>. In this situation, components (A) and (B) may be the same. Since Blum teaches that the prepolymeric compounds may be used by themselves in column 10, lines 44-45, when (A) and (B) are the same, it appears that applicant's claims are not distinguished from the prior art.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

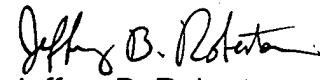
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey B. Robertson whose telephone number is (571) 272-1092. The examiner can normally be reached on Mon-Fri 7:00-3:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P Gulakowski can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jeffrey B. Robertson  
Primary Examiner  
Art Unit 1712

JBR